

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number.	: 10/084,856	Confirmation No.	: 6222
Applicants	: Douglas U. Mennie et al.	Customer No.	: 41230
Filed	: February 27, 2002	Docket No.	: 247171-
TC/A.U.	: 3694		000373USD1
Examiner	: Matthew D. Osborne		

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Commissioner:

This Pre-Appeal Brief Request for Review is responsive to the Final Office Action mailed December 31, 2007, and Advisory Action mailed May 9, 2008.

I. SPECIFICATION OBJECTION/CLAIM REJECTION – 35 U.S.C. § 112, 1ST PAR.

The test for evaluating issues of written description is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. It is not necessary that the application describe the claim limitations exactly, but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations. *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976) (citation omitted). **The Examiner must have a *reasonable* basis to challenge the adequacy of the written description and bears the initial burden of presenting by a preponderance of evidence “why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.”** *In re Wertheim*, 541 F.2d at 263. The Examiner has not discharged this burden.

¶ [0397] of Appellant's specification states that “[a] coin transaction is described in greater detail in FIG. 56f” wherein, “[a]s shown, a customer loads mixed coins into the system at step 12a” and “[t]he coins are sorted, authenticated, and bagged one at a time.” ¶ [0416] states that “the system may include a coin sorting and discrimination module 19” and that “FIGS. 58-61 illustrate a disc-type coin sorter used in coin sorting and discrimination module 19 that uses a coin-driving member having a resilient surface for moving coins along a metal coin-guiding surface of a stationary coin-guiding member.” Further, ¶ [416] discloses that “the coin-driving member is a rotating disc, and the coin-guiding member is a stationary sorting head” and that “[a]s can be seen

in FIG. 58, a hopper 1510 receives coins of mixed denominations and feeds them through central openings in a housing 1511 and a coin-guiding member in the form of an annular sorting head or guide plate 1512 inside or underneath the housing” wherein, “[a]s the coins pass through these openings, they are deposited on the top surface of a coin-driving member in the form of a rotatable disc 1513.” (*see also* The AMERICAN HERITAGE DICTIONARY, SECOND COLLEGE EDITION, which defines “hopper” as “. . . 2. . . b. Any of various other receptacles in which something is held in readiness prior to usage”). The use of a “hopper” to feed coins would be understood by one of ordinary skill in the art to mean a receptacle that accepts a large quantity of coins. U.S. Pat. 2,750,949, incorporated by reference in the present application (i.e., constituting a part of the written description), shows an example of a “coin hopper 31” (see FIGS. 1, 13). ¶ [0397] likewise discloses a coin transaction in which “a customer *loads* mixed coins into the system at step 12a” (emphasis added)(*see, e.g.*, The AMERICAN HERITAGE DICTIONARY, SECOND COLLEGE EDITION, which defines “load” as, for example, “To provide or fill nearly to overflowing”), whereupon the coins are “sorted,” as disclosed. In this regard, it is noted that FIG. 59 shows 38 coins being simultaneously sorted by the sorting head 1512. ¶¶ [0416]-[0462] describe how the input coins are sorted and/or discriminated and counted. The entire structure of the disclosed machine is clearly configured for high speed *sorting* of bulk coins (e.g., batches and sub-batches of coins), from the use of a hopper 1510 (see ¶ [0416]); FIG. 58) to the disclosure that the sorting operation is “high speed” (*see, e.g.*, ¶¶ [0419]- [0420]). This structure is designed for speed and bulk coin processing, as would be immediately recognized by one of ordinary skill in the art.

Again, it bears emphasis that the test is whether the disclosure reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. One of ordinary skill in the art at the time of the invention would be well aware of published information, including Appellant’s own published literature, such as, but not limited to, those submitted in the Information Disclosure Statement filed on August 3, 2006. These references, which are of record, include Cummins JetSort® High Speed Coin Sorter/Counter Model 1701 – Product Information Manual (1987)” (which discloses, *inter alia*, that the C-A JetSort 1701 processes “6,000 coins per minute,” shows on page 5 a picture a sorting head similar to that depicted in the present application, and shows, in numerous places, a coin tray full of coins); “Cummins-Allison Corp. JetSort® Parts & Service Manual for Model CA-1701 (©1987)” (showing on pages 82-83 an isometric exploded view showing coin hopper assembly 5) and manual lift tray assembly 7 in relation to the underlying sorting disc and sorting head (see, e.g., FIGS. 4B-1 and 4C-1 on pages 12-13 therein and associated

description relating to removal of hopper for maintenance)); and “Cummins-Allison Corp. – JetSort® Series 750, 1750, 1760 & 1770 Service Manual” (page 107 shows a top view of a coin hopper 1). These references and numerous other Cummins-Allison publications, which are of record in the present case, form a part of what would have been well-known to one of ordinary skill in the art at the time of the invention. The C-A coin sorter in the present application is a high-speed coin sorter, such as is discussed, by way of example, in “Cummins-Allison Corp. – AMS Cummins Automated Money Systems – Case Study “High Speed Coin Processing Power at Covenco Vending” (1st print July, 1983), 2 pages,” of record, which discloses that Convensco Vending used the Appellant’s JetSort machines to “sort and count mixed coin at up to 6,000 coins per minute and to verify single denominations at up to 10,000 minute” and to process “\$10,000 - \$12,000 in coin in about two minutes”. This, and other, prior art of record shows what was known to those of ordinary skill in the art at the time of the invention. Information which is well known in the art need not be described in detail in the specification. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379-80 (Fed. Cir. 1986).

Still further, ¶ [0416] incorporates by reference coin sorters including U.S. Pat. Nos. 4,543,969 and 5,299,977, both assigned to the present assignee, which disclose, for example, that “[s]ome businesses, particularly banks, are often faced with a large amount of coin currency at the end of a business day, week or month which must be organized, counted and recorded” and that “[t]o make counting of coins less laborious, machines have been developed which automatically sort by denomination a mixed group of coins” (‘969, col. 1, lines 14-23)(see Fig. 1). The ‘969 patent further discloses that “[a] collection of mixed denomination coins are dropped onto the surface of the rotating disk through a central opening in the stationary disk whereby the rotating disk imparts a rotational movement to the coins” (col. 1, lines 59-63) and that “[t]o start the sorting process a collection of mixed denomination coins 11 is dropped onto a staging platform 13 which is an integral part of a housing cover 15.” (col. 3, lines 50-53). The ‘969 patent also discloses that “[t]he coins 11 are manually pushed along the gentle sloping incline of the staging platform 13 and fall into a hopper 17 as indicated by the arrows in FIG. 1” whereupon “[t]he coins are directed by the hopper 17 into the coin sorter apparatus which is comprised of a rotating disk 19 and a stationary disk 21, shown in cross-section in FIG. 1” (*see, e.g.,* col. 3, lines 45-62). Both the ‘969 and ‘977 patents disclose a C-A disc-type coin sorter and hopper (*see, e.g.,* FIG. 2 of the ‘977 patent). The ‘977 patent discloses, for example, that in one embodiment, the disc speed is 250 rpm and that the disc turns and the coins move at a rate of “1.5° per millisecond” (*see, e.g.,* col., 12,

lines 28-29; col. 13, lines 53-55). Coins are correspondingly processed and discharged at a high rate of speed (see, e.g., FIGS. 24, 51). This incorporated non-essential material forms a part of Appellant's disclosure and would have reasonably informed a reading thereof.

Appellants submit that, for at least the above reasons, no new matter has been added and requests withdrawal of both the above-noted objection and the 35 U.S.C. § 112, ¶ 1 rejection.

II. CLAIM REJECTION – 35 U.S.C. § 112, 2ND PARAGRAPH

The Examiner rejected claims 258-261 and 267-270 under 35 U.S.C. § 112, 2nd paragraph, as being indefinite for its use of the term “singulating.” This rejection is traversed. Definiteness of claim language must be analyzed in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one of ordinary skill in the art at the time the invention was made. The essential inquiry is whether the claims set out and circumscribe a particular subject matter with a *reasonable* degree of clarity. Whether more suitable language or modes of expression are available is not the requisite test.

3,587 patents and published patent applications use the term “singulating.” Within the art, one example of its usage is shown in US Pat. No. 5,988,348, of record, which discloses that coins “are *singulated* by a coin pickup assembly” (abstract), that “stacked coins tip backwards into a recess and slide over supporting coins *to facilitate singulation*” (col. 3, line 66 to col. 4, line 2), and that “[t]he coin rail 56 functions to receive coins output by the coin pickup assembly 54, and transports the coins *in a singulated (one-at-a-time) fashion* past the sensor 58” (col. 13, lines 27-31)(emphasis added). US Pat. No. 6,059,650 to Stoltz et al. discloses a “System and method for coin *singulation*” directed to “separating or *singulating* individual coins from a plurality of coins, and more particularly to an automated system and method for accepting a plurality of mixed denomination coins and outputting them serially for further action such as validation and counting.” (col. 1, lines 5-10)(emphasis added). This term is well known. One of ordinary skill in the art at the time of the invention would, in light of the content of the application disclosure (*see, e.g.,* ¶¶ [0420]-[0430]), the teachings of the prior art (*see, e.g.,* art of record), and the claim interpretation that would be given by such person at the time the invention was made, would not find the claims indefinite. Appellants request reconsideration and withdrawal of this rejection.

III. CLAIM REJECTION - 35 U.S.C. § 103

Smith does not disclose or suggest, as alleged, “a coin separation device (col. 5, line 30 – col. 10, line 55)” (*see* Final Office Action, page 5). The customer of the vending machine separates the coins and places them, one at a time, in slot 35. Smith's vending machine performs no

“separation” of coins or sorting, nor has the MC5 line of coin changers been shown, explicitly or inherently, to disclose or suggest separation of coins, as alleged (e.g., as opposed to, for example, simply validating and summing the coins individually placed into the slot).

The Examiner has not shown evidence that Smith discloses dispensing of a technological device. The Examiner’s attempt to cast the inquiry in the negative to rely not upon what is taught but what is not explicitly excluded lacks evidentiary basis and fails to discharge the evidentiary burden incumbent upon the Examiner to present a *prima facie* case of unpatentability. *See, e.g., In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Both Smith and Avnet fail to disclose or suggest an “act of receiving money input by said customer comprising substantially simultaneously receiving, in a bulk coin receptacle, randomly oriented bulk coins input by said customer” (claim 258). Avnet discloses on col. 2, line 3, that “coins” are accepted, Avnet discloses and suggests nothing more than a conventional vending machine apparatus comprising a coin slot that is not configured to permit substantially simultaneously receiving, in a bulk coin receptacle, randomly oriented bulk coins input by a customer. Likewise, both Smith and Avnet fail to disclose or suggest, for example, an act of “singulating the bulk coins using a coin separation device.” Similar to claim 258, discussed above, Appellants respectfully submit that Smith and Avnet fail to disclose or suggest, singly or in combination, at least the acts of “receiving bulk coins input by said customer, said act of receiving bulk coins comprising substantially simultaneously receiving, in a bulk coin receptacle, randomly oriented bulk coins input by said customer” or “singulating the bulk coins using a coin separation device” (claims 268-270).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. Appellants respectfully submit that Smith and Avnet fail to disclose or suggest, singly or in combination, all of the claim limitations of independent independent claims 258 and 268, or of claims depending therefrom.

Reconsideration and withdrawal of the pending rejections are requested.

Respectfully submitted,

May 15, 2008
Date

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 247171-000373USD1
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	First Named Inventor Douglas U. Mennie	
	Art Unit 3694	Examiner Swartz, Jamie
<p>Applicant requests review of the final rejection in the above-identified application.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 60%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,988</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 35%; text-align: center;"> <p><u>/William D. PEGG, Reg. # 42,988/</u> Signature</p> <p><u>William D. Pegg</u> Typed or printed name</p> <p><u>(312) 425-8657</u> Telephone number</p> <p><u>May 15, 2008</u> Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>		
<input checked="" type="checkbox"/> *Total of <u>2</u> forms are submitted.		